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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,880	07/29/2003	Harry Leneau	29792-73218	5579

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ICE MILLER LLP
ONE AMERICAN SQUARE, SUITE 3100
INDIANAPOLIS, IN 46282-0200

EXAMINER

SASAN, ARADHANA

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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08/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/629,880

Applicant(s)

LENEAU, HARRY

Examiner

Aradhana Sasan

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/03, 7/16/04, 12/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. The remarks and declaration filed on 11/7/06 are acknowledged.
2. Claims 1-13 are included in the prosecution.

Information Disclosure Statement

3. The information disclosure statement filed 7/29/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but all the information referred to therein has not been considered. Please see attached PTO-1449.

Response to Arguments

4. **Rejection of claims 1-13 on the ground of nonstatutory obviousness-type double patenting over claims 1-7 of US 6,607,745**

Applicant's filing of the terminal disclaimer (11/7/06) overcomes the rejection of claims 1-13 on the ground of nonstatutory obviousness-type double patenting over claims 1-7 of US 6,607,745.

5. **Rejection of claims 1-13 under 35 USC § 112, first paragraph, enablement**

Applicant's arguments with respect to the rejection of claims 1-13 under 35 USC § 112, first paragraph, as not providing enablement for all joint disorders, have been fully considered. Applicant argues that the number of joint disorders referenced within the application would enable one skilled in the art to use the invention commensurate in

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scope with these claims and that no undue experimentation would be required to use the invention. Applicant's declaration regarding the treatment for one or more joint disorders when treating another joint disorder was found persuasive and the rejection of 5/4/06 has been withdrawn.

6. Rejection of claim 9 under 35 USC § 112, first paragraph, written description

Applicant's arguments with respect to the rejection of claim 9 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement, have been fully considered and are found persuasive. The rejection of 5/4/06 has been withdrawn.

7. Rejection of claims 1-13 under 35 USC § 102(e) as being anticipated by Pierce (US 6,924,273)

8. Applicant's arguments and declaration of prior inventorship with respect to the rejection of claims 1-13 under 35 USC § 102(e) as being anticipated by Pierce (US 6,924,273) have been fully considered but they are not persuasive. Since applicant is claiming the same invention as Pierce, the declaration of prior inventorship is not sufficient to overcome the 35 USC § 102(e) rejection. See MPEP § 715.05.

Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c).

The rejection of 5/4/06 is maintained.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Pierce US 6924273.

Pierce teaches a method of treating or preventing osteoarthritis, joint inflammation and pain by administering to a mammal hyaluronic acid (col. 4, lines 46-55 and col. 5, lines 30-35). The reference teaches using 0.1-0.5 mg of hyaluronic acid per kg of body weight in the composition (col. 9, lines 34-39). The reference teaches the effective amount for canines range from 2-8 mg. The compositions can be in the form of a paste, gel, tablets, and capsules (col. 11, lines 59-60). Example discloses a hyaluronic composition that comprises water as the food acceptable carrier (col. 17, lines 1-15).

Conclusion

11. No claims are allowed.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aradhana Sasan whose telephone number is (571) 272-9022. The examiner can normally be reached Monday to Thursday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600